



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#23  
9-21-01

In re application of:

Geoffrey B. Rhoads

Filed: November 5, 1998

For: METHOD FOR MONITORING  
INTERNET DISSEMINATION OF  
IMAGE, VIDEO AND/OR AUDIO  
FILES

Examiner: J. Couso

Date: September 21, 2001

Response Under 37 CFR § 1.116  
Expedited Procedure

Art Unit 2621

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on September 21, 2001 as First Class Mail in an envelope addressed to: BOX AF ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231.

Joel R. Meyer  
Attorney for Applicant

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Sir:

This reply brief is in response to the Examiner's Answer mailed July 24, 2001. Please charge any deficiency to deposit account 50-1071.

The following issue is on appeal:

- Did the Office establish a prima facie case of obviousness in rejecting claims 2-21 as obvious over U.S. Patent No. 5,721,788 to Powell in view of U.S. Patent No. 4,977,594 to Shear, when (a) the references – collectively – fail to detail all of the elements claimed, and (b) there is no teaching or suggestion in the art that would have led an artisan to modify and combine the references as proposed?

Appellant's Brief establishes that the cited prior art, either alone or in combination, fails to show all of the limitations of the pending claims. As set forth in the Federal Circuit's recent case, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693, 2001 U.S. App. LEXIS 17219 (Fed. Cir. Aug. 2, 2001), there is no need to examine whether there is a motivation to combine the cited references if the prior art fails to disclose at least one of the limitations of the claimed invention.

Since Appellant's Brief has already identified claim limitations that Powell and Shear collectively fail to disclose, there is no need to repeat those arguments in this reply brief. However, Appellant wishes to address some of the points raised in the Examiner's Answer. Throughout the Answer, the Examiner has characterized Appellant's description of steganography and digital watermarking and concludes that the embedded digital signatures in Powell are exactly the same as the digital embedded watermark in applicant's claimed invention.

Appellant has acknowledged that Powell teaches a form of embedding a digital watermark. However, Powell fails to disclose claimed limitations relating to decoding digital watermark data and using that decoded data as set forth in detail in Appellant's Brief. Shear does not disclose these limitations missing from Powell because it has nothing to do with steganography or watermarking.

The Answer does not refute Appellant's position that Shear fails to disclose any method of steganography or digital watermarking. Previously, the Examiner only relied on Shear as disclosing "obtaining image files from plural different Internet sites." However, the Examiner now has cited Shear as allegedly teaching elements of claims 3 and 4, which recite decoding the digital watermark data with reference to public key data and private key data, respectively. Shear describes the use of a key for decryption, not digital watermark decoding.

Throughout the Answer, the Examiner acknowledges that Powell and Shear do not disclose recited limitations, but concludes with no supporting evidence that these limitations would have been obvious to one of ordinary skill in the art. In doing so, the Examiner views the claim limitations in isolation, without considering the context of the claims. For example, the Answer ignores that claims 5-11 are dependent claims which each further define the process of "identifying plural of the obtained files having certain digital watermark date embedded therein"

recited in independent claim 2. In the context of this "identifying" process of claim 2, the dependent claim elements that further elaborate on this process are clearly not taught or suggested by Powell or Shear as set forth in Appellant's brief.

With respect to claim 8, the Examiner contends that "the claim language does not recite the specific claim language now being argued." The pertinent part of Appellant's brief regarding claim 8 refers to "the claimed use of a one dimensional domain transform for identifying files." Dependent claim 8 recites that the domain transformation of claim 5 is "a one dimensional transform", and dependent claim 5 recites that "the identifying" process of claim 2 "includes performing a domain transformation on data from at least certain of said files, yielding transformed data." Clearly, the combination of claims 2, 5, and 8, which are linked by dependencies, have the claim elements being argued by Appellant in connection with claim 8.

In a number of instances, such as for claims 7, 9, 10-12, the Examiner acknowledges that Powell and Shear do not disclose certain claim limitations, but concludes that they are well known. In particular, for claims 10-12 on page 16 of the Answer, the Examiner concludes that the claims call for well known computations. Yet, these conclusions ignore the fact that dependent claims 10-11 further define the "identifying" process of claim 2, and claim 12 refers to a particular operation used "to identify the possible presence of digital watermark data therein." When properly viewed in the context of the claim, these computations are not obvious.

At page 17 of the Answer, the Examiner provides new arguments regarding claim 17. Previously, the Examiner primarily relied on Powell to reject claim 17, and only cited Shear for the process of "obtaining audio or image files from plural different internet sites" of claim 2. Now, in the Answer, the Examiner concludes that the combined teachings of Powell and Shear teach the elements of claim 17, namely, "the decoded watermark data provides a reference to a registry database, and the method further includes obtaining additional data from the registry database by use of said reference, said additional data identifying the proprietor of the file from which said watermark data was decoded." The Examiner then states on page 17 that the combination of the references also teach "a computer having a first memory storing data representing a plurality of creator identifiers and creator contact data corresponding to each of

the creator identifiers.” This language appears to be substantially copied from different claims in another of Appellant’s applications (09/545,174), which is also on Appeal. The Answer fails to articulate how Powell or Shear teach the elements of claim 17, but instead refers to claim elements from claims in application no. 09/545,174.

This copied language from claims in application no. 09/545,174 also appears in the paragraph spanning pages 11-12, and on page 18 of the Answer.

The Answer contains other instances where the cited art is applied to different claim limitations of another of Appellant’s applications, rather than the claim at issue. For example, on page 4, lines 9-17 of the Answer, the Examiner appears to be referring to elements of claims in application no. 09/560,976, rather than elements of claim 2 in the application at issue. Application no. 09/560,976 is also on appeal. The Examiner repeats this same reference to elements of claims in 09/560,976 on pages 8 and 10.

The Appellant respectfully disagrees with the Examiner’s positions in the Answer for all the claims, and the positions in the Appellant’s brief still stand. As such, there is no need to further reiterate the positions of the brief. It is particularly unproductive to attempt to reply to the Examiner’s arguments where they refer to claim language copied from different claims in other patent applications before the Examiner.

Because the combined teachings of Powell and Shear fail to disclose all of the limitations of the claims, it is not necessary to examine the issue of motivation to combine these references. However, to be complete, it is useful to look at the reasons offered for combining these references. Initially, the Examiner only relied on Shear as purportedly showing “obtaining audio or image files from plural different Internet sites.” Though this is not a central issue for the appeal, it is worth noting that Shear does not specifically refer to or discuss Internet communications. Moreover, the primary objective of Shear’s method is to provide a database usage metering system so that databases can be distributed to end-user’s hard drives and used locally rather than accessed remotely.

Now, in the Answer, the Examiner relies on Shear for other aspects of the claims, such as elements of claims 3-4 and 17. Shear teaches a method of measuring database usage that is

unrelated to the claimed use of digital watermark technology. Shear's system uses a form of encrypted database, yet as explained in Appellant's brief, encryption is not equivalent to watermarking or steganography.

It is accurate to note that Powell teaches a method of determining whether a suspect image is derived from another image, yet this is a different use of digital watermarking. Shear teaches a method of measuring database usage that is unrelated to the claimed use of digital watermark technology. Due to the disparities of the uses of the technologies in the respective references and the claims, there is no motivation to combine the references to yield the claimed invention.

## CONCLUSION

In view of the foregoing, applicant respectfully submits that a *prima facie* case of obviousness has not been established as to any of claims 2-21. Accordingly, the rejections of claims 2-21 should be reversed, and the application returned to the Art Unit for issuance of a Notice of Allowability.

Date: September 21, 2001

Respectfully submitted,



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Art Unit 2621

Geoffrey B. Rhoads

Serial No. 09/186,962

Filed: November 5, 1998

For: METHOD FOR MONITORING  
INTERNET DISSEMINATION  
OF IMAGE, VIDEO AND/OR  
AUDIO FILES

Examiner: J. Couso

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CERTIFICATE OF MAILING

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Joel R. Meyer  
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TRANSMITTAL LETTER

## ASSISTANT COMMISSIONER FOR PATENTS:

- Enclosed for filing in the above-captioned matter is a Reply Brief (in triplicate).
- No fee is believed due. However, please charge any fees which may be required in connection with filing these documents, or credit any overpayment, to Deposit Account No. 50-1071.

Date: September 21, 2001

Respectfully submitted,



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